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Reexamination Control No. 95/000,089
U.S. Patent No. 6,615,485 B2

CENTRAL REEXAMINATION UNIT

PATENT

Attorney Docket No. 074442-0012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Benjamin Niles Eldridge et al.

U.S. Patent No. 6,615,485 B2

Reexamination Control No.: 95/000,358

**Reexamination Request Filed: March 14,
2008**

**For: PROBE CARD ASSEMBLY AND KIT,
AND METHODS OF MAKING THE SAME.**

Customer No.:

Examiner: Flanagan, Beverly, Meindl

Technology Center/Art Unit: 3993

**REQUEST FOR AN ENLARGEMENT
OF THE 50 PAGE LIMIT RULE OF 37
C.F.R. § 1.943(b) TO RESPOND TO AN
OFFICE ACTION**

**Mail Stop Inter Partes Reexamination
Central Reexamination Unit
Office of Patent Legal Administration**

**United State Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450**

Sir:

**PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE
PROVISIONS OF 37 C.F.R. § 1.183**

**Mail Stop Inter Partes Reexam
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450**

Sir:

Reexamination Control No. 95/000,358
U.S. Patent No. 6,615,485 B2
Page 2

PATENT

The Patent Owner hereby petitions the Commissioner of Patents to exercise his supervisory authority under the provisions of 37 C.F.R. §1.183 to suspend the provisions rule 37 C.F.R §1.943(b) mandating that the response by the patent owner not exceed 50 pages in length.

Under extraordinary circumstances, when justice requires, any requirement of the regulations appearing in 37 C.F.R. Part 1 et. seq., which is not a requirement of the statutes, may be suspended or waived. A petition under 37 C.F.R. §1.183 is appropriate here where the facts establish the existence of an extraordinary circumstance such that justice requires the suspension or waiver requested.

Petitions under 37 C.F.R. §1.183 to suspend or waive a requirement of the regulations require:

1. Showing of extraordinary circumstances where justice requires the suspension or waiver.
2. Petition fee; 37 C.F.R. 1.17(h).
3. Prompt and diligent filing.
4. Compliance with any requirement of the regulation in question which is not specifically suspended or waived or with such other requirements as may be imposed.

As set forth herein, the Patent Owner has complied with all of the above requirements 1-3, and agrees to comply and follow other appropriate requirements. Specifically, the Patent Owner requests suspension of the above "50 page" rule because the examiners has issued

Reexamination Control No. 95/000,358
U.S. Patent No. 6,615,485 B2
Page 3

PATENT

a multiplicity of rejections that results in a seventy (70) page Office Action¹ that is based on a reexamination request of one hundred and forty two (142) pages. The Patent Owner's responsibility is to address thirty (30) separate grounds of rejections in the Office Action - including fourteen (14) anticipation rejections and sixteen (16) obviousness rejections - on one or more of claims 1-12, 15, 18-25, 29-38, and 41-42.

It is respectfully submitted that the requested extension will not prejudice any third-party, including the third-party requester of this *Inter partes* reexamination. Accordingly, it is in the interest of justice to allow the Patent Owner to have a full and fair opportunity to address each of the grounds, which can only be accomplished by suspending the 50 page response rule of 37 C.F.R. §1.1943(b).

In view of the reasons stated above, an extension of time of two months is requested to

THE REGULATORY REQUIREMENTS

The extraordinary situation is best explained by reference to the regulations regarding *inter partes* reexamination. The requirements of 37 C.F.R. § 1.937(b) state that in rendering a prior art rejection for in *inter partes* proceedings, the examiner is to comply with the provisions of 37 C.F.R. § 1.104 relating to examination of the patent application.

The provisions of 37 C.F.R. § 1.104 require that the examiner use the best available prior art in rendering a novelty or obviousness rejection. As set forth in the regulation:

¹ The number of cumulative rejections applied to one or more of claims 1-12, 15, 18-25, 29-38, and 41-42 is assumed to be the "best available prior art" pursuant to the provisions of 37 C.F.R. § 1.104. While it understood that the examiner must address all rejections proposed by a third party requester despite the office practice to not make
(continued...)

Reexamination Control No. 95/000,358
U.S. Patent No. 6,615,485 B2
Page 4

PATENT

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command."

The meaning of the best available prior art is set forth in the MPEP, which is a guideline for the examiner. According to the MPEP 706.2, I., the "CHOICE OF PRIOR ART; BEST AVAILABLE," states:

"Prior art rejections should ordinarily be confined strictly to the best available prior art."² Merely cumulative rejections, i.e., those which would clearly fail if the primary rejection were not sustained, should be avoided."

As set forth in the MPEP, "merely cumulative rejections" are to be avoided. If they are not, then it is apparent that the requirement that the best available prior art be applied cannot be met. Here, the fact remains that thirty (30) separate grounds of rejections of the have been adopted -- with eleven (11) anticipation rejections of both independent claims 1 and 32. There can be no question that the Patent Owner's burden to address each and every rejection on one or more of claims 1-12, 15, 18-25, 29-38, and 41-42 in a 50 page response is simply not practical. By way of example, the 50 page limit allows on average less than two (2) pages to developed in a response to each of the rejections where some - like the anticipation rejection of Beaman - reject thirty two (32) claims.

With this background, it is apparent that the requirement of 37 C.F.R. § 1.943(b) stating that the Patent Owner's response cannot exceed fifty (50) pages in length places a

cumulative rejections during examination (see MPEP § 706.02(I)), the fact remains that the Patent Owner must respond to the multiplicity of rejections in the Office Action.

² The section continues to state "Exceptions may properly be made, for example, where (A) the proprietary of a 35 U.S.C. 102 or 103 rejection depends on a particular interpretation of a claim; (B) a claim is only met only in terms by a reference which does not disclose the inventive concept involved; or (C) the most pertinent reference seems likely to be antedated by a 37 C.F.R. 1.131 affidavit or declaration. Such rejections should be backed up by the best other art rejections available..